

Confirm. No. 7638
512425-2103**REMARKS**

Reconsideration and withdrawal of the rejections of this application and consideration and entry of this paper are respectfully requested in view of the herein remarks, which place the application in condition for allowance.

I. STATUS OF CLAIMS AND FORMAL MATTERS

Claims 1-27 are pending in this application. The applicants appreciate the acknowledgement of allowable subject matter for claims 9, 11 and 12 if rewritten in independent form. In order to advance prosecution, claims 1, 3 and 13 have been amended to delete reference to amino alcohols; the applicants reserve the right to pursue this subject matter in a continuing application. No new matter has been added by this amendment.

It is submitted that the claims, herewith and as originally presented, are patentably distinct over the prior art cited in the Office Action, and that these claims were in full compliance with the requirements of 35 U.S.C. § 112. The amendments of the claims, as presented herein, are not made for purposes of patentability within the meaning of 35 U.S.C. §§§§ 101, 102, 103 or 112. Rather, these amendments and additions are made simply for clarification and to round out the scope of protection to which Applicants are entitled.

II. THE §112, 2ND PARAGRAPH REJECTIONS HAVE BEEN OVERCOME

Claims 1-27 were rejected under 35 U.S.C. §112, second paragraph as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Reconsideration in light of the amendment to the claims and the arguments presented below is respectfully requested.

- a. In claim 1, the reaction of an Si-H moiety with an alcohol forms the alkoxy moiety. As such there is nothing confusing about the description of the end product.
- b. The dependency of claims 6 and 7 have been amended to refer to claim 1.
- c. Triethylborane and boron trichloride have been separated by a comma (the scope of the claim later includes "mixtures thereof"). It was unclear why reference to (7I), (8I) and (9I) needed to be deleted as this assists one of ordinary skill in the art to find more information about the compounds, e.g. (7I) = 7th Chemical Index, but in order to advance prosecution, these labels have been deleted. Tris(perfluorotriphenylborane) is the chemical synonym for pentafluorophenylborane (see CAS Reg. No. [1109-15-5]); this typographical error has been corrected.

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- d. The spelling of ---polyorganosiloxane--- has been corrected in claim 16.
- e. Although claim 17 is believed to signal a definite claim scope to those of skill in the art. in order to advance prosecution, this specific claim is being cancelled. The subject matter intended to be claimed by claim 17 is still encompassed by independent claim 1. Applicants reserve the right to file a continuing application to further argue the merits of original claim 17.
- f. Claims 18 and 22 have been amended to indicate that y can be from 1 to 100.
- g. Claim 25 has been amended to indicate that the product is produced by the claimed process.
- h. The spelling of ---polyorganosiloxane--- has been corrected in claim 16.
(As appropriate, correction of the spelling of the term ---integer--- was made in claims 18, 20 and 22).

III. THE 35 U.S.C. §102(e) REJECTION HAS BEEN OVERCOME

- 1. Claims 1-5, 10, 13, 15-19 and 24-27 were rejected as allegedly being anticipated by Boudjouk et al. (U.S. Patent 6,482,912 - "Boudjouk").

MPEP 2131 illustrates the requirements necessary to establish anticipation:

- (1) "A claim is anticipated only if each and every element set forth in the claim is found, either expressly or inherently described, in a single prior art reference." see *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987); and
- (2) "The identical invention must be shown in as complete detail as is contained in the...claim." see *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

However for the reasons explained below, the Boudjouk reference does not meet these requirements for establishing anticipation for the claims as amended.

The Boudjouk reference refers to a process of preparing aminofunctional alkoxy polysiloxanes. With the amendments to the claims, the applicants process no longer encompasses making aminofunctional alkoxy polysiloxanes and as such the claims are not anticipated by the Boudjouk reference.

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While the amendment to the claims was made to advance prosecution, it is noted that even without the amendment to claims 1, 3 and 13 to remove reference to aminoalcohols, the Boudjouk reference still did not anticipate the applicants' claimed invention.

First, despite a reference to uranium and $((\text{Et}_2\text{N})_3\text{U}(\text{B}(\text{C}_6\text{H}_5)_4))$ in Table 3 and Y and YCl_3 in Table 4, it is not clear that Boudjouk actually could be said to have described (i.e. has possession of the invention at the time of filing) this element which is part of the applicants' claimed invention. Boudjouk clearly directs his invention to transition metal elements which are outside the scope of catalysts claimed by the applicants, i.e. Cr, Cu, Ir, Mn, Ni, Pd, Pt, Rh, Ru, Ti and Zn (see col. 3, lines 22-23) or Pd, Cu, Mn, Ni, Rh, Ru, Pt, Zn, Ir, Cr, and Ti (see col. 7, lines 35-37). Given the relative lack of description in Boudjouk, it would be hard pressed to even assert that the Boudjouk reference was even descriptive or enabling for anything beyond rhodium-based catalysts; a fact which appears conceded by Boudjouk as there is no specific reference to any other sort of catalyst in their claims.

Second, even if it were able to be proven that Boudjouk adequately described and enabled a broad range of catalysts, their teachings would not extend to the main group III or transition group III catalysts used by the applicants in their invention. As the overwhelming number of catalysts referred to in Boudjouk is outside the scope of the applicants' invention, it cannot be said that Boudjouk shows the applicants identical invention in as complete detail as is contained in the applicants' claim.

Therefore, for any of the above reasons, the applicants' claims are not anticipated by Boudjouk.

IV. THE 35 U.S.C. §103(a) REJECTION HAS BEEN OVERCOME

MPEP 2143.03 states in part that "To establish *prima facie* obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art." *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)".

1. Claims 14, 20 and 21 were rejected as allegedly being obvious over Boudjouk et al., *supra*.

The applicants response with regard to Boudjouk in section III, paragraph 1 is to be considered repeated here and as such all limitations are not taught and for this reason alone, the claims are not obvious over Boudjouk.

In addition, for claim 14, while optimization of condition can be a basis for obviousness (see MPEP 2144.05, section II. A. - Optimization Within Prior Art Conditions or Through

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Routine Experimentation), this is only applicable if the particular parameter was first be recognized as a result-effective variable (see MPEP 2144.05, **section II. B. - Only Result-Effective Variables Can Be Optimized**). There is no basis for the assertion presented in the office action from within the teachings of Boudjouk.

With regard to claims 20 and 21, these claims are ultimately dependent upon claim 12, which was indicated to be allowable if rewritten in independent form.

2. **Claims 6 and 7 were rejected as allegedly being obvious over Boudjouk et al., *supra* (as applied to claims 1-5) in view of Blackwell et al. (*J. Org. Chem.*, 64:4887-4892 (1999) - "Blackwell") or WO 01/74938 - as interpreted by Deforth (U.S. Patent Application Publication 2003-0139287)**

The applicants response with regard to Boudjouk in section III, paragraph 1 is to be considered repeated here and as such all limitations are not taught and for this reason alone, the claims are not obvious over Boudjouk and Blackwell or Deforth.

In addition, while Blackwell and Deforth refer to various boron catalysts, there is no teaching of direction from either of these references (or Boudjouk) to use them in the process of Boudjouk. As noted above, Boudjouk referred to numerous other catalysts beyond his enabling example for rhodium and still did not elect to encompass boron related catalysts of the type claimed by the applicants. Moreover, each of the processes referred to in references cited are different, Boudjouk (amino functional alkoxy polysiloxanes); Blackwell (silation of alcohols); and Deforth (polymerization or crosslinking of silicone). There is no teaching or direction which would suggest that taking a catalyst from one type of process would be applicable to another type of process. At best, the collection of references might establish an "obvious to try" rationale, but this is not the proper standard for establishing a *prima facie* case of obviousness.

3. **Claim 8 was rejected as allegedly being obvious over Boudjouk et al., *supra* (as applied to claims 1-5) in view of Beattie et al. (U.S. Patent 3,541,127 - "Beattie")**

The applicants response with regard to Boudjouk in section III, paragraph 1 is to be considered repeated here and as such all limitations are not taught and for this reason alone, the claims are not obvious over Boudjouk and Beattie.

In addition, similar to the applicants' response in paragraph 2 above, Beattie teaches use of a catalyst from within the scope of the applicants' claimed invention, but for a different process, i.e. Beattie teaches the production of polysiloxanes which are only the starting material for the applicants alkoxy-substituted polysiloxanes (or the amino alkoxy siloxanes of Boudjouk). Again, there is no teaching or direction which would suggest that taking a catalyst from one type

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of process would be applicable to another type of process. At best, the collection of references might establish an "obvious to try" rationale, but this is not the proper standard for establishing a *prima facie* case of obviousness.

REQUEST FOR INTERVIEW

In the interest of adhering to the tenets of compact prosecution and obtaining good customer service (see page 7 of the FY-2004 Performance and Accountability Report), the applicants request that the teachings of MPEP 707.07(j), sections II and III be applied, especially with regard to the offer of suggestion for correction by the Examiner if the rejections are upheld.

In accordance with MPEP 713.01, section III, should any issue remain as an impediment to allowance, an interview with the Examiner and SPE are respectfully requested; and, the Examiner is additionally requested to contact the undersigned to arrange a mutually convenient time and manner for such an interview ("An interview should normally be arranged for in advance, as by letter, facsimile, electronic mail, telegram or telephone call, in order to insure that the primary examiner and/or the examiner in charge of the application will be present in the office." *Id.*).

CONCLUSION

In view of the remarks and amendments herewith, the application is believed to be in condition for allowance. Favorable reconsideration of the application and prompt issuance of a Notice of Allowance are earnestly solicited. The undersigned looks forward to hearing favorably from the Examiner at an early date, and, the Examiner is invited to telephonically contact the undersigned to advance prosecution. The Commission is authorized to charge any fee occasioned by this paper, or credit any overpayment of such fees, to Deposit Account No. 50-0320.

Respectfully submitted,
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